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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,023	11/19/2003	Thomas P. Branch	45011-271086	3205

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EXAMINER

DOSTER GREENE, DINNATIA JO

ART UNIT PAPER NUMBER

3743

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,023

Applicant(s)

BRANCH, THOMAS P.

Examiner

Dinnatia Doster-Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detail Action</u> . |

DETAILED ACTION***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. **Specifically, the patents cited on page 2 of the specification are not listed on the Information Disclosure Statement.**

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **220 and 320**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing

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figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 5 is objected to because of the following informalities: The limitation "said bladder" lacks proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamont (U.S. Patent No. 5,453,082) in view of Gleason (U.S. Patent No. 2,543,248). Lamont discloses a medical boot 10 which includes an inflatable member 86 positioned beneath a user's foot proximate the toes and insole 37 such that alternate plantarflexion and dorsiflexion of the foot is provided (Lamont, col. 4, lines 23-66). Although Lamont does not specifically disclose an inflatable member positioned above the user's foot proximate the toes, Lamont does teach that an additional inflatable member 32 can be

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used in other locations within the medical boot (Lamont, Fig. 4 and col. 4, line 67-col. 5, line 2). Furthermore, Gleason which also relates to a device for stimulating a limb of a user by inflating and deflating an inflatable member (diaphragm 32) teaches that it is known in the art to position inflatable members on both the top and the both of a user's limb (Gleason, Figs. 5-6 and cols. 1-3). Thus, it would have been obvious to one skilled in the art at the time of the invention to modify the medical boot of Lamont based upon the teaching of Gleason to include an inflatable member and a second flap positioned above the user's foot wherein the second flap is positioned between the inflatable member and the user's foot for the purpose of providing more effective plantarflexion and dorsiflexion of the user's foot.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5-8 are rejected under the judicially created doctrine of double patenting over claims 18, 19 and 23 of U. S. Patent No. 6,669,660 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

All the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, with the exception that newly presented claim 5 recites "said elbow tends to be bent" whereas claim 18 of the patent claims "said elbow tends to be straightened" in the final paragraph of the patented claim.

Claim 9 is rejected under the judicially created doctrine of double patenting over claim 43 of U. S. Patent No. 6,669,660 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

As admitted by Applicant, all the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, with the exception that newly presented claim 9 recites the phrase "abduction" whereas claim 43 of the patent claims "external rotation" in the final paragraph of the patented claim.

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Claim 10 is rejected under the judicially created doctrine of double patenting over claim 42 of U. S. Patent No. 6,669,660 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

As admitted by Applicant, all the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, with the exception that newly presented claim 10 recites the phrase "inflatable member" whereas claim 42 of the patent claims "spacing wedge" in the fourth paragraph of the patented claim.

Claim 11 is rejected under the judicially created doctrine of double patenting over claim 4 of U. S. Patent No. 6,669,660 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

As admitted by Applicant, all the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, with the exception that newly presented claim 4 recites the phrase "retention member" whereas claim 4 of the patent claims "flexible strap" in the final paragraph of the patented claim.

Claims 12-15 are rejected under the judicially created doctrine of double patenting over claims 7-10, respectively, of U. S. Patent No. 6,669,660 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

As admitted by Applicant, all the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, with the exception that newly presented claim 12 does not contain the limitation "when in both above-referenced position, yet while in said first position" in the third paragraph of the patented claim.

Claim 16 is rejected under the judicially created doctrine of double patenting over claims 11 of U. S. Patent No. 6,669,660 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

As admitted by Applicant, all the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, with the exception that newly presented claim 16 does not contain the limitation "attached to said second end of said strap" as recited in the third paragraph in independent claim 7 from which claim 11 depends.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kawaguchi et al. (U.S. Patent No. 6,238,357); Santana (U.S. Patent No. 5,312,322); Backman (U.S. Patent No. 5,236,411); Davis et al. (U.S. Patent No. 5,288,286); Tornsjö (U.S. Patent No. 1,950,331); Goldsmith (U.S. Patent No. 5,407,421); and Dakin et al. (U.S. Patent No. 6,409,691).

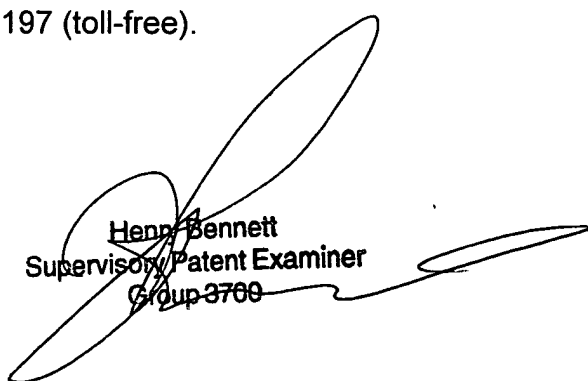
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinnatia Doster-Greene whose telephone number is 571-272-7143. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ddg



Henry Bennett
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